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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,534	03/01/2004	Robert K. Holzwarth	H10522/JDP	2751
1333 7590 10/30/2007 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER RODRIGUEZ, LENNIN R	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 10/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,534

Applicant(s)

HOLZWARTH ET AL.

Examiner

Lennin R. Rodriguez

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/04/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

(1) 325 in Fig. 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "401" has been used to designate both sheet 1 and sheet 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version

of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show **"six physical pages (401 – 406)"** as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(1) page 20, line 26 “**313**”.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-22 are rejected to under 37 CFR 1.75 as being a substantial duplicate of limitations. In claim 18, lines 6-7 and lines 9-10 are reciting the same limitations and it is unclear as to whether the applicant is referring to (a) “a computer readable indicia”

as recited in line 3 of the same claim or (b) to the “altered computer readable indicia” recited in line 8. If it is referring to (a) then why are the two limitations in the claim, the examiner respectfully request an explanation or clarification of this matter, or on the other hand if it is referring to (b) then “the computer readable indicia should read – the **altered** computer readable indicia --.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kremer et al. (US Application 2001/0043365).

(1) regarding claim 1:

Kremer '365 discloses a printing system for placing content within a document (Fig. 1) comprising:

a computational element (114 in Fig. 2) coupled to a user interface (Fig. 3)

a routine (paragraph [0027], lines 16-17 where the operation is performed through a software), within the computational element (114 in Fig. 2), that allows entry of a computer readable indicia into an electronic version of the document for a specific type of content that is to be applied to a set of pages within the document (paragraph [0016], lines 1-5); and

a module within the computational element that applies the specific set content to the set of pages (paragraph [0016], lines 7-10).

(2) regarding claim 11:

Kremer '365 further discloses a method for placing content within a document comprising the steps of:

providing a print job for a document defined by an electronic format (paragraph [0022], lines 8-13);

entering into the electronic format a computer readable indicia (paragraph [0027], lines 16-17 where the operation is performed through a software) that identifies a specific type of content and a set of pages on which the specific type of content is to be placed (paragraph [0016], lines 1-5), and

processing the electronic format by interpreting the computer readable indicia as it applies for each page within the document (paragraph [0016], lines 7-10).

(3) regarding claim 2:

Kremer '365 further discloses wherein the computer readable indicia (paragraph [0027], lines 16-17 where the operation is performed through a software) further comprises either a flag, a tag, a marker or a variable that is placed into the electronic version of the document to indicate which of the set of pages are to receive the specific type of content (paragraph [0016], lines 1-5).

(4) regarding claims 3 and 12:

Kremer '365 further discloses wherein the flag, a tag, a marker or a variable is placed on every piece of media within the document (paragraph [0016], lines 1-5 and paragraph [0030], lines 33-36).

(5) regarding claims 4 and 13:

Kremer '365 further discloses wherein the set of pages further comprises a subset of all pages within the document (paragraph [0045], lines 16-20).

(6) regarding claim 5:

Kremer '365 further discloses wherein the specific type of content further comprises a page number (paragraph [0030], lines 4-8).

(7) regarding claim 6:

Kremer '365 further discloses wherein the specific type of content further comprises the placement of the page number on each page from the document (paragraph [0027], lines 3-6).

(8) regarding claim 7:

Kremer '365 further discloses wherein the specific content further comprises a font type for the page number (paragraph [0043], lines 12-14).

(9) regarding claim 8:

Kremer '365 further discloses wherein the specific type of content further comprises either a graphic, a header, a footer or a watermark (paragraph [0030], lines 30-32).

(10) regarding claim 9:

Kremer '365 further discloses wherein the routine allows entry of the indicia to indicate which pages of a least one set of pre-collated media are to receive the specific content (paragraph [0027], lines 8-18).

(11) regarding claim 10:

Kremer '365 further discloses wherein the module further comprises a determination of pages that will receive the specific content (paragraph [0016], lines 1-5), and the determination of pages including multiple iterations by the routine that adds new pages to the electronic version of the document (paragraph [0027], where the determination is being done by a software and as it is common knowledge software contains iterations).

(12) regarding claim 14:

Kremer '365 further discloses wherein the step of entering further comprises the step of iteratively editing the electronic version of the document to include at least one different media type played with the computer readable indicia (paragraph [0027], lines 1-6).

(13) regarding claim 15:

Kremer '365 further discloses wherein the step of processing further comprises responding to the step of iteratively editing to place the specific content on pages in accordance with the indicia that has been placed on the different media types (paragraph [0035], where in the preflight stage 204 the editing function is being performed for every indicia).

(14) regarding claim 16:

Kremer '365 further discloses wherein the step of providing further comprises electronic format being a graphical language (paragraph [0025], lines 17-19).

(15) regarding claim 17:

Kremer '365 further discloses wherein the step of providing further comprises the graphical language being PDF (paragraph [0025], lines 17-19).

(16) regarding claim 18:

Kremer '365 further discloses a method for placing content within a document comprising the steps of:

providing a print job for a document defined by an electronic format (paragraph [0022], lines 8-13);

entering into the electronic format a computer readable indicia (paragraph [0027], lines 16-17 where the operation is performed through a software) that identifies a specific type of content and a set of pages on which the specific type of content is to be placed (paragraph [0016], lines 1-5), and

processing the electronic format by interpreting the computer readable indicia as it applies for each page within the document (paragraph [0016], lines 7-10);

altering the computer readable indicia (paragraph [0035], where in the preflight stage 204 the editing function is being performed for every indicia); and,

processing the electronic format by interpreting the computer readable indicia as it applies for each page within the document (paragraph [0035] and 206 of Fig. 2).

(17) regarding claim 19:

Kremer '365 further discloses wherein altering comprises removing content from certain pages (paragraph [0043], lines 2-5, where one of the editing options is to erase or cut).

(18) regarding claim 22:

Kremer '365 further discloses wherein processing comprises not printing page content (paragraph [0043], lines 5-7, where cropping an area will prevent that area from printing thus not printing page content).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kremer et al. (US Application 2001/0043365) in view of Krist et al. (EP 0 478 351 A2).

Kremer '365 discloses all the subject matter as described above except wherein altering comprises removing page numbers and the processing comprises recalculating the page numbers.

However, Krist '351 teaches wherein altering comprises removing page numbers (page 7, lines 49-51, where an user can remove the page numbers from certain pages) and the processing comprises recalculating the page numbers (page 7, lines 49-56,

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where the system automatically skips putting number on specified pages and renumber the ones left).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that altering comprises removing page numbers and the processing comprises recalculating the page numbers as taught by Krist '351, in the system of Kremer '365. With this the system allows the users to have more flexibility when printing a print job, since maybe not all the pages need to be numbered 9page 7, line 49), thus becoming user friendlier.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lennin R. Rodriguez whose telephone number is (571) 270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lennin Rodriguez
10/24/07



KING Y. POON
SUPERVISORY PATENT EXAMINER